

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: § Group Art Unit: 3626
§
Nobuyoshi Morimoto § Examiner: Tomaszewski, Michael
§
§ Atty. Dkt. No.: 5596-00901
§
Serial No. 10/045,649 §
§
Filed: November 7, 2001 §
§
For: System and Method for §
Arranging Shipment and §
Insurance for an Item §
§
§

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir/Madam:

Further to the Notice of Appeal filed July 27, 2007, Appellant presents this Appeal Brief. Appellant respectfully requests that the Board of Patent Appeals and Interferences consider this appeal.

I. **REAL PARTY IN INTEREST**

The subject application is owned by NIHON DOT.COM CO., LTD. (d.b.a. ColonDot.com).

II. RELATED APPEALS AND INTERFERENCES

No other appeals, interferences or judicial proceedings are known which would be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

Claims 1-20 are pending in the application and stand finally rejected. The rejection of claims 1-20 is being appealed. A copy of the appealed claims, as currently pending, is included in the Claims Appendix herein below.

IV. STATUS OF AMENDMENTS

No amendments have been submitted subsequent to the final rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1 is directed toward a method for arranging insurance for an item (*see e.g.*, page 26, line 14 – page 27, line 24; Figure 5b). The method includes receiving a request to insure the item being shipped from an origination to a final destination (*see e.g.*, page 26, lines 14-20; Figure 5b, item 123). The method also includes searching a database for a cost effective insurance that provides a specified level of insurance coverage for the item (*see e.g.*, page 26, line 22 – page 27, line 2; page 22, lines 20-24; Figure 5b, item 125). The method also includes generating a data file that includes at least item information and insurer information (*see e.g.*, page 21, line 15 – page 22, line 8; page 17, line 10 – page 18, line 19; Figure 5a, items 114-116; Figure 4, item 50A). The method also includes storing the data file in a memory device that accompanies the item (*see e.g.*, page 21, line 15 – page 22, line 8; page 17, line 10 – page 18, line 19; Figure 5a, items 114-116; Figure 4, item 50A).

Claim 19 is directed toward a system for arranging insurance for an item being shipped. The system includes a memory device that stores information about the item (*see e.g.*, page 21, line 15 – page 22, line 8; page 17, line 10 – page 18, line 19; Figure 5a, items 114-116; Figure 4, item 50A). The memory device also accompanies the item (*see e.g.*, page 7, line 29-30; Figure 1A, items 50A-D; Figure 4, item 50A). The system also includes a server that is connected to the memory device (*see e.g.*, page 36, line 23 – page 37, line 18; Figure 10, items 90, 40A-D and 50A-D). The server is configured to communicate with the memory device using a network (*see e.g.*, page 36, line 23 – page 37, line 18; Figure 10, items 90, 40A-D and 50A-D). The server is also configured to receive a request to insure the item being shipped from an origination to a final destination (*see e.g.*, page 26, lines 14-20; Figure 5b, item 123). The server is further configured to search a database for a cost effective insurance that provides maximum insurance coverage for the item for the least cost (*see e.g.*, page 26, line 22 – page 27, line 2; page 22, lines 20-24; Figure 5b, item 125). The server is also configured to generate a data file that includes at least item information and insurer information (*see e.g.*, page 21, line 15 – page 22, line 8; page 17, line 10 – page 18, line 19; Figure 5a,

items 114-116; Figure 4, item 50A). The server is also configured to store the data file in the memory device that accompanies the item (*see e.g.*, page 21, line 15 – page 22, line 8; page 17, line 10 – page 18, line 19; Figure 5a, items 114-116; Figure 4, item 50A).

Claim 20 is directed toward a computer-readable storage medium that stores program instructions (*see e.g.*, page 37, lines 21-29; Figure 11, items 360). The program instructions are executable by a computer system to implement a method that includes receiving a request to insure the item being shipped from an origination to a final destination (*see e.g.*, page 26, lines 14-20; Figure 5b, item 123). The method implemented by the program instructions further includes searching a database for a cost effective insurance that provides maximum insurance coverage for the item for the least cost (*see e.g.*, page 26, line 22 – page 27, line 2; page 22, lines 20-24; Figure 5b, item 125). The method implemented by the program instructions also includes generating a data file that includes at least item information and insurer information (*see e.g.*, page 21, line 15 – page 22, line 8; page 17, line 10 – page 18, line 19; Figure 5a, items 114-116; Figure 4, item 50A). The method implemented by the program instructions also includes storing the data file in a memory device that accompanies the item (*see e.g.*, page 21, line 15 – page 22, line 8; page 17, line 10 – page 18, line 19; Figure 5a, items 114-116; Figure 4, item 50A).

The summary above describes various examples and embodiments of the claimed subject matter; however, the claims are not necessarily limited to any of these examples and embodiments. The claims should be interpreted based on the wording of the respective claims.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-3, 8, 12-15 and 20 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Parcel Insurance Plan (www.pipinsure.com; English translation; hereinafter “Pipinsure”) in view of Keuper (DE 44 46 203 A1) (hereinafter “Keuper”).

2. Claims 4, 6, 9 and 19 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Pipinsure in view of Keuper in further view of Kadaba et al. (U.S. Patent 6,285,916) (hereinafter “Kadaba”).

3. Claims 5, 7, 10-11 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Pipinsure in view of Keuper in further view of Official Notice.

4. Claim 16 stands finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Pipinsure in view of Keuper in further view of eBay (<http://www.ebay.com>) (hereinafter “eBay”).

5. Claims 17 stands finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Pipinsure in view of Keuper in further view of Chen et al. (U.S. Patent 5,504,674) (hereinafter “Chen”).

6. Claims 18 stands finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Pipinsure in view of Keuper in further view of Kepler et al. (U.S. Patent 5,347,845) (hereinafter “Kepler”).

VII. ARGUMENT

First Ground of Rejection:

Claims 1-3, 8, 12-15 and 20 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Pipinsure in view of Keuper. Appellant traverses these rejections for at least the following reasons. Different groups of claims are addressed under their respective subheadings.

Claims 1, 2, 3, 12, 13 and 14

In regard to claim 1, contrary to the Examiner's assertion, the combination of cited art fails to teach or suggest a method for arranging insurance for an item, wherein the method comprises, in part, receiving a request to insure the item being shipped from an origination to a final destination. The Examiner cites page 8 of PIPinsure that includes a form to request a savings quote. Clearly, a request *for a savings quote* is not a request *to insure a particular item that is actually being shipped*. PIPinsure discloses a series of questions a user can answer to “request a free quote on your package insurance needs.” The questions pertain to *general characteristics* of a user’s shipping *habits* including *average* number of packages insured per day and *average* value per insured package. Thus, instead of a specific package, the form addresses packages in the aggregate on average. A request for a saving quote regarding aggregated average shipments over days or months cannot be considered a request to insure a particular item being shipped from an origination to a final destination. Additionally, a business typically provides a *quote* to help facilitate a customer’s decision on whether to order a service or product. **Thus, a *quote* is requested *before* a customer actually decides whether to request a given service or product.** Furthermore, PIPinsure fails to disclose an origination or a final destination for a specific item. Thus, for numerous reasons, PIPinsure clearly does not teach or suggest receiving a request to insure the item being shipped from an origination to a final destination.

Keuper describes a barrel tag transponder that stores data pertaining to the contents of the barrel, such as identification, filling date, beer grade, etc. Keuper has nothing to do with a request to insure an item. Also, Keuper is non-analogous art. Thus, PIPinsure and Keuper, taken singly or in combination, fail to teach or suggest a request to insure an item being shipped from an origination to a final destination.

In the Response to Arguments, the Examiner “disagrees with Applicant’s PIPinsure interpretation, which appears to be have been done in a vacuum.” **However, the Examiner’s response is based solely and completely on the Examiner’s own speculation unsupported by any evidence of record.** For instance, the Examiner first argues that PIPinsure’s “request for a saving quote is inherently a request to insure an item” and that “broadly and reasonably speaking, a request for a savings quote is a tacit request to insure an item, irrespective whether the request is consummated.” The Examiner provides no evidence in support of these broad, conclusory statements of opinion. Moreover, the Examiner’s assertion is simply not correct and is not supported by the actual disclosure of the PIPinsure reference. As discussed above, PIPinsure only discusses a *savings* quote based on *general characteristics* of a user’s shipping *habits* including *average* number of packages insured per day and *average* value per insured package. Nowhere does PIPinsure describe receiving a request to insure a particular item actually being shipped from an origination to a final destination. Appellant’s assertions are not made “in a vacuum”. Instead, Appellant’s assertions are made based on the explicit teachings of the evidence of record.

Secondly, Examiner states, “a skilled artisan in the insurance and parcel shipping arts would easily glean from the complete PIPinsure teachings that a request to insure an item is taught and suggested by the PIPinsure reference.” **However, the Examiner’s assertion is not supported by the actual teachings of the reference.** PIPinsure clearly only discusses shipping quotes based on average/aggregate shipping *habits*. PIPinsure does not discussing receiving a request to insure any particular item that is actually being shipped. The Examiner has not provided any evidence to support the conclusion that one

skilled in the art would recognize receiving a request to insure an item as inherently included in PIPinsure's system.

Thirdly, the Examiner argues, “Applicant was not the first to invent the concept of insuring items to be shipped from an origination to a final destination.” **However, Appellant has never made any such argument.** Moreover, Appellant’s claim does not recite merely the general concept of insuring items to be shipped from an origination to a final destination. Instead, Appellant’s claim recites a specific method including the specific limitation of receiving a request to insure the item being shipped from an origination to a final destination *in combination with* other limitations. Appellant asserts that this limitation *in combination with* the other limitations of Appellant’s claim is not taught by the cited art. It is the Examiner who shoulders the burden of proof to establish a *prima facie* rejection. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968). Appellant also strongly objects to the Examiner rejecting Appellants’ claims based on the “gist” of Appellants’ claim. M.P.E.P states at §2141, “the claimed invention must be considered as a whole.” As stated in M.P.E.P at §2141.02, it is clearly improper to distill an invention down to the “gist” or “thrust”. Specifically, “distilling an invention down to the ‘gist’ or ‘thrust’ of an invention disregards the requirement of analyzing the subject matter as a whole.” That is exactly the situation with the Examiner’s rejection. The Examiner argues that “Applicant was not the first to invent the concept of insuring items to be shipped from an origination to a final destination.” The Examiner is clearly ignoring the specific limitations recited in Appellants’ claim and is instead rejecting Appellants’ claim based on the Examiner’s opinion that Appellants were not “the first to invent the concept of insuring items to be shipped from an origination to a final destination.” The Examiner has clearly improperly distilled Appellants’ invention down to a ‘gist’ or ‘thrust’. Thus, the Examiner’s basis for rejection is improper.

While the “express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims,” “the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that

result or characteristic” (M.P.E.P. §2112, “Examiner must provide rationale or evidence tending to show inherency”) and “the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” The Examiner’s rejection appears to be based on the Examiner’s opinion, unsupported by evidence, that “receiving a request to insure an item being shipped from an origination to a final destination” is inherent in PIPinsure. However, PIPinsure’s saving quote is simply a free quote estimating the *amount of savings* a *potential* customer may obtain by using the PIPinsure service. How PIPinsure would provide actual insurance for any given item is not described in the cited reference. For example, even if actual insurance was provided, the PIPinsure system might provide insurance on a bulk, aggregate or average basis. Thus, there is no requirement that the PIPinsure system would ever have to receive a request to insure a particular item being shipped from a particular origination to a particular destination. The Examiner’s speculation, unsupported by evidence or technical reasoning, does not change the fact that, contrary to the Examiner’s contention, PIPinsure’s saving quote, even if combined with the Examiner’s other cited art, does not inherently include, teach or suggest *receiving a request to insure an item being shipped from an origination to a final destination*. Thus, the Examiner’s rejection is clearly improper.

The Examiner further states, “PIPinsure is not in the business of merely providing savings quotes; rather, PIPinsure is in the business of insuring parcels (i.e., items to be shipped)” and that “a skilled artisan in the insurance and parcel shipping arts would easily glean from the complete PIPinsure teachings that a request to insure an item is taught and suggested by the PIPinsure reference.” **However, regardless of any additional business or services that the Examiner believes may be provided by PIPinsure, the issue at hand is whether the PIPinsure reference cited by the Examiner (the actual evidence of record) teaches or suggest the specific limitations recited in claim 1, which it clearly does not.** As noted above, even if actual insurance were provided, the PIPinsure system might provide insurance on a bulk, aggregate or average basis. Thus, there is no requirement that the PIPinsure system would ever have to receive a request to insure a

particular item being shipped from a particular origination to a particular destination. The Examiner's reliance on PIPinsure, whether considered singly or in combination with the Examiner's other cited art, to teach or suggest (either explicitly, implicitly, or inherently) *receiving a request to insure the item being shipped from an origination to a final destination* is clearly misplaced.

Additionally, the Examiner's citing of page 18 of PIPinsure regarding an origination and destination has nothing whatsoever to do with either a request to insure an item being shipped from an origination to a final destination or PIPinsure's request for saving quote. Instead, at page 18, cited by the Examiner to support the erroneous contention that PIPinsure includes "insuring parcels (i.e., items) from an origination to a final destination", PIPinsure compares the cost of shipping items via expedited services (such as overnight shipping) to the cost of slower forms of shipping (such as standard ground shipping). **Page 18 has nothing to with insuring parcels and clearly fails to teach or suggest, even if combined with the Examiner's other cited art, anything regarding receiving a request to insure an item being shipped from an origination to a final destination.**

Furthermore, this particular argument by the Examiner is irrelevant. Appellants' have never argued that PIPinsure could not insure items or that items can not be shipped from an origination to a final destination. Instead, as noted above, Appellant argues that PIPinsure, even if combined with the Examiner's other cited art, does not teach or suggest the specific limitation of receiving a request to insure a particular item being shipped from a particular origination to a particular final destination.

The Examiner also argues that "applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references." However, Appellants do not argue against the references individually. Any argument regarding an individual reference is intended to show that the Examiner's reliance on that particular reference is misplaced. In other words, whether considered alone or in combination, the references

do not support the Examiner's assertions. Thus, the Examiner's statement regarding Appellants arguing against the references individually is incorrect.

Further in regard to claim 1, the Examiner's combination of cited art also fails to teach or suggest searching a database for a cost effective insurance, wherein the cost effective insurance provides a specified level of insurance coverage for the item. The Examiner asserts PIPinsure discloses this limitation on page 1. However, page 1 of PIPinsure merely discloses a simple table of annual potential savings dependent on a declared package value and number of shipments per day. **A table of potential savings is not the same as searching a database for a cost effective insurance, wherein the cost effective insurance provides a specified level of insurance coverage for the particular item.** In fact, a table of potential savings on a web page is completely different than searching a database for a cost effective insurance, wherein the cost effective insurance provides a specified level of insurance coverage for the item. Thus, PIPinsure and Keuper, taken singly or in combination, fail to teach or suggest searching a database for a cost effective insurance, wherein the cost effective insurance provides a specified level of insurance coverage for the item.

In the Response to Arguments, the Examiner again responds to Appellant's arguments by citing page 18 of PIPinsure. However as noted above, page 18 of PIPinsure has nothing to do with *insuring* an item. Instead, page 18 compares the cost of expedited shipping over regular shipping. **Nothing about the table illustrated on page 18 has anything whatsoever to do with *insuring* an item or about searching a database for a cost effective insurance.** Thus the Examiner's contention the table on page 18 somehow teaches or suggests searching a database for a cost effective insurance that provides a specified level of insurance coverage for a particular item is clearly erroneous.

Without providing any actual evidence, the Examiner also provides his own speculation that the United States Postal Service, Federal Express, United Parcel Service, etc, "developed and used" "the concept of searching insurance databases having specified

levels of insurance coverage for items” “well prior to Applicant’s claimed invention.” However, once again, the Examiner is rejecting Appellants’ claim based solely on the Examiner’s own speculation regarding the specific functionality of shipping services (e.g., USPS, FedEx, UPS, etc) “well prior to Applicant’s claimed invention.” In spite of Appellant’s previous request for the Examiner to provide actual evidence supporting his reliance on United States Postal Service, Federal Express and/or United Parcel Service as prior art, the Examiner has not provided any proper prior art reference that clearly demonstrates that one or more of these services included searching a database for a cost effective insurance that provides a specified level of *insurance* coverage for the particular item. **There is no evidence of record to support the Examiner’s assertions.** Moreover, it again appears that the Examiner is again attempting to boil Appellant’s claim down to a “gist” of the invention. As discussed above, this is not a proper basis for rejection.

Further regarding claim 1, the cited art fails to teach or suggest generating a data file comprising at least item information and insurer information. The Examiner cites page 8 of PIPinsure that discloses a form to request a savings quote. As described above, the form includes text fields to allow a user to enter answers to questions pertaining to a user’s aggregated shipping habits. However, a form on a web page that allows users to request a savings quote is not the same as generating a data file comprising at least item information and insurer information. As discussed above, PIPinsure discloses a series of questions that pertain to general characteristics of a user’s shipping *habits* including *average* number of packages insured per day and *average* value per insured package. **However, *insurer information* is not disclosed in any of the questions presented in the savings quote form of PIPinsure. Moreover, PIPinsure makes no mention of generating any data file.** The mere existence of a web form for requesting a saving quote regarding a user’s aggregated shipping habits does not imply the generation of a file including specific item information and insurer information. Clearly, PIPinsure and Keuper, taken singly or in combination, fail to teach or suggest generating a data file comprising at least item information and insurer information.

Once again, the Examiner's response to Appellant's argument is merely speculation unsupported by any evidence or technical reasoning. Specifically, the Examiner restates the unsupported assertion that "PIPinsure does indeed teach and suggest generating a data file comprising at least item information and insurer information." The Examiner then states, again without any supporting evidence or technical reasoning, that "those of ordinary skill in the art are well aware of this technique that was developed as used well prior to Applicants' claimed invention", making reference to United States Postal Service, Federal Express, United Parcel Service, etc. **However, the Examiner's unsupported speculations do not refute Appellant's argument as to the actual teachings of the evidence of record, namely that the discussion of PIPinsure's savings quote at page 8 (as cited by the Examiner) does not teach, suggest or mention, even if combined with the Examiner's other cited art, generating a data file including at least item information and insurer information.** Instead, The Examiner appears to be arguing that the mere existence of a WEB-based entry form somehow inherently includes generating a data file including at least item information and insurer information, as recited in Appellants' claim. However, as noted above, it is well established that mere statements of conclusion or opinion are not sufficient for a proper rejection. Instead, the Examiner must provide actual evidence to show that the characteristic relied upon, in this case generating a data file including at least item information and insurer information, is necessarily present in the reference. Such is not the situation in the present case.

Additionally in regard to claim 1, the cited art fails to teach or suggest storing the data file, containing both item information and insurer information, in a memory device that accompanies the item. The Examiner admits that PIPinsure fails to disclose this limitation and relies on Keuper to disclose storing the data file in a memory device that accompanies the item. As noted above, Keuper describes a barrel tag transponder that stores data pertaining to the contents of the barrel. Keuper describes on page 8, lines 3-11:

This problem is solved in the following manner: during (or after) the filling of the barrel, filling data, such as the filling date and identification concerning the type of fluid charged in such as the beer grade, the filling

volume, a sequential filling number, etc. are transmitted from the transmitting/receiving device to the transponder and are there stored as data set in a pollable manner is [sic] such a way that the data even at a later point in time cannot only be read out elsewhere but can also be updated.

As shown above, the data stored in Keuper's barrel tag transponder pertains to a barrel's contents. **The data stored in Keuper's barrel tag transponder does not include insurer information.** In fact, information such as the filling data disclosed by Keuper has absolutely nothing to do with insurer information. Furthermore, as argued above, PIPinsure fails to teach or suggest a data file containing both item information and insurer information. Thus, neither Keuper nor PIPinsure, taken singly or in combination, teach or suggest a method for arranging insurance for an item, wherein the method comprises, in part, storing the data file, containing item information and insurer information, in a memory device that accompanies the item.

In the response to arguments, the Examiner argues that "PIPinsure teaches insurer information" and that "Keuper teaches storing data files in memory devices that accompany an item." **However, nothing in either PIPinsure or Keuper, even if considered in combination, teaches or suggests storing insurer information in a data file in a memory device that accompanies the item.** The PIPinsure reference, as argued above, does not teach or suggest, even if combined with Keuper, insurer information that would accompany an item, as in Appellants' claim. Instead, PIPinsure merely describes general savings information, such as an estimate of insurance savings that a potential customer may expect. Nor does Keuper teach storing the data file, containing item information and insurer information, in a memory device that accompanies the item. Thus, whether considered singly or in combination, PIPinsure and Keuper do not teach or suggest storing the data file, containing item information and insurer information, in a memory device that accompanies the item.

Furthermore, the Examiner has failed to provide a proper reason for combining the teaching of PIPinsure with the teachings of Keuper. The Examiner asserts: "One of ordinary skill would have found it obvious at the time of the invention to

combine the teachings of Keuper with the teachings of PIPinsure with the motivation of acquiring shipment-handling data on an item.” However, PIPinsure teaches relying on the shipment carrier to maintain shipment-handling data for a particular item. For instance, PIPinsure teaches that prior to filing a claim with PIPinsure, a user should “[f]ile a tracer with the carrier without delay when a package is lost” and a copy of the carrier’s tracer form is a required document when filing a claim (PIPinsure, page 5). Thus, one of ordinary skill in the art would not be motivated to modify the teachings of PIPinsure to include the “keg tag” of Keuper to acquire shipment-handling data on an item because PIPinsure already utilizes a specific method of acquiring shipment-handling data – namely relying upon the independent shipping carriers to track shipments. One of ordinary skill in the art would simply use the teachings of PIPinsure to acquire shipment-handling data on an item. Moreover, “acquiring shipment-handling data on an item” provides no reason to also store insurer information with the item information in the data file in a memory device that accompanies the item.

In the Response to Arguments, the Examiner merely states, “Examiner respectfully submits that the motivations to combine the references used throughout this rejection are adequate.” However, stating a conclusory opinion that the motivations are adequate fails to address Appellant’s specific arguments regarding the fact that there is no reason why one of ordinary skill would modify the teachings of PIPinsure and Keuper, as required by the Examiner’s rejection. For instance, Appellant has argued that the Examiner’s stated reason, namely that of “acquiring shipment-handling data on an item” is not adequate for various reasons, such as because PIPinsure already describes a perfectly reasonable method for acquiring shipment-handling data. Moreover, “acquiring shipment-handling data on an item” provides no reason to also store insurer information with the item information in the data file in a memory device that accompanies the item. Thus, rather than providing a proper reason to modify the cited art, the Examiner has merely stated the Examiner’s conclusory opinion, unsupported by any explanation or evidence, that the reasons are adequate. The Examiner has clearly failed to meet the burden of establishing a *prima facie* obviousness rejection.

Additionally, it would not make sense to modify PIPinsure to use the keg tags of Keuper. Since, as noted above, PIPinsure provides insurance for packages shipped using independent carriers, such as Airborne Express, DHL, FedEx, UPS, and the U.S. Postal Service, among others. Thus, the packages being insured never actually pass through a PIPinsure facility. In order to use the keg tags of Keuper, PIPinsure would have to receive each item, attach Keuper keg tag storing a data file including both item identification and insurer information, and then ship the package via the appropriate carrier. Clearly, such a process is not described by the references. Nor does it make sense to modify PIPinsure as suggested by the Examiner. The Examiner has failed to rebut these arguments in his Response to Arguments.

Furthermore, the references are not properly combinable because Keuper is non-analogous art to PIPinsure. One of ordinary skill in the art would not combine teachings directed to beer keg tags with the teachings of PIPinsure. The keg tags of Keuper are not analogous art to PIPinsure.

Moreover, for at least the reasons given above, even if the references were combined, such a combination would not result in Appellant's claimed invention. To establish a *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP 2143.03. For the numerous reasons discussed above, the cited art clearly does not teach or suggest all limitations combined as recited in the currently pending claims.

Furthermore, the Pipinsure reference has not been shown to be prior art to the present application. The Examiner has not properly established a publication date of the Pipinsure reference. The Examiner relies on the website <http://www.archive.org> for establishing that the Pipinsure reference was available as of 2000. However, there is no guarantee that the dates or even the content of what is supplied by <http://www.archive.org> is accurate. Appellant notes that the Terms of Use for <http://www.archive.org> (see <http://www.archive.org/about/terms.php>) state:

You understand and agree that the Archive makes no warranty or representation regarding the accuracy, currency, completeness, reliability, or usefulness of the content in the Collections, that the Site or the Collections will meet your requirements, that access to the Collections will be uninterrupted, timely, secure, or error free, or that defects, if any, will be corrected. We make no warranty of any kind, either express or implied.

Thus, since <http://www.archive.org> does not guarantee the accuracy of its collections, Appellant asserts that it is not proper to rely on <http://www.archive.org> to establish a publication date. Furthermore, even if the Pipinsure reference was published prior to Appellant's date of invention, there is no guarantee that the copy downloaded by the Examiner is an *accurate copy of what was published*. **This is especially true since <http://www.archive.org> specifically states that they do not guarantee the accuracy of their content.**

For the above reasons, Appellant asserts that there is insufficient evidence of record to establish that the Pipinsure reference downloaded by the Examiner qualifies as prior art. Also, as noted above, even if the Pipinsure reference is prior art, Pipinsure in view of Keuper fails to teach or suggest the specific limitations of claim 1 as demonstrated above.

Thus, the rejection of claim 1 is unsupported by the cited art and removal thereof is respectfully requested.

Claim 8

In regard to claim 8, Pipinsure and Keuper, taken singly or in combination, fail to teach or suggest wherein the data file further comprises contact information for at least one of the insurance companies that will insure the item. The Examiner cites pages 2-3 of Pipinsure. While page 2-3 of Pipinsure discloses a phone number, address, and email address associated with the Parcel Insurance Plan, nowhere does Pipinsure teach or suggest that such information is comprised within a data file in a memory device that accompanies the item. The Examiner has not addressed the specific

limitations of claim 8. Neither Pipinsure nor Keuper, taken singly or in combination, teach or suggest a data file, which comprises contact information for at least one of the insurance companies that will insure the item, in a memory device that accompanies the item. Appellants also note that the Examiner has not provided any reason as to why one of ordinary skill in the art would be motivated to combine the teaching of Pipinsure with the teachings of Keuper to create the invention as specified by the specific limitations of claim 8. Furthermore, even were such a combination to be made, it would not result in Appellants claimed invention.

Thus, the rejection of claim 8 is unsupported by the cited art and removal thereof is respectfully requested.

Claim 15

Further regarding claim 15, Pipinsure in view of Keuper fails to teach or suggest generating a data file comprising *insurance information*. The Examiner cites page 8 of PIPinsure that discloses a form to request a savings quote. As described above, the form includes text fields to allow a user to enter answers to questions pertaining to a user's aggregated shipping habits. However, a form on a web page that allows users to request a savings quote is not the same as generating a data file comprising *insurance information*. As discussed above, PIPinsure discloses a series of questions that pertain to general characteristics of a user's shipping *habits* including *average* number of packages insured per day and *average* value per insured package. **However, *insurance information* is not disclosed in any of the questions presented in the savings quote form of PIPinsure. Moreover, PIPinsure makes no mention of generating any data file.** The mere existence of a web form for requesting a saving quote regarding a user's aggregated shipping habits does not imply the generation of a file including specific item information and insurance information. Appellants also note that Keuper fails to disclose that his "keg tag" includes *insurance information*. Clearly, PIPinsure and Keuper, taken singly or in combination, fail to teach or suggest generating a data file comprising at least item information and insurer information.

Thus, the rejection of claim 15 is unsupported by the cited art and removal thereof is respectfully requested.

Claim 20

In regard to claim 20, Appellant asserts the rejection of claim 20 is unsupported by the cited art for at least reasons similar to those presented above in regard to claim 1. **Furthermore, Appellant asserts neither PIPinsure nor Keuper, taken singly or in combination, teach or suggest program instruction computer executable to receive a request to insure the item being shipped from an origination to a final destination, search a database for a cost effective insurance, wherein the cost effective insurance provides maximum insurance coverage for the item for the least cost, generate a data file comprising at least the following item information, and insurer information, and store the data file in the memory device that accompanies the item.** The Examiner asserts “Claim 20 substantially repeats the same limitations as claim 1 and therefore, is rejected for the same reasons given for claim 1 and incorporated herein.” **The Examiner has improperly ignored the specific differences between the claim limitations of claims 1 and 20.** Claim 1 does not recite program instructions computer executable to perform the specific actions **as recited in claim 20.**

Additionally in regard to claim 20, the cited art also fails to teach or suggest program instructions executable to search a database for a cost effective insurance providing maximum insurance coverage for an item for the least cost. For example, the cited art of PIPinsure discloses a web form a user may fill out to request a savings quote. The Examiner also cites PIPinsure’s simple table of annual potential savings dependent on a declared package value and number of shipments per day. A *savings quote* and *a table of potential savings* have nothing to do with **providing maximum insurance coverage for an item for the least cost** as recited in claim 20. Furthermore, Keuper discloses a barrel tag transponder that stores data pertaining to the contents of the barrel. The cited art of Keuper has absolutely nothing to do with *insurance* much less

providing maximum insurance coverage for an item for the least cost. Keuper and PIPinsure, taken singly or in combination, fail to disclose providing maximum insurance coverage for an item for the least cost. Clearly, Keuper and PIPinsure, taken singly or in combination, fail to disclose providing maximum insurance coverage for an item for the least cost.

Furthermore, the Pipinsure reference has not been shown to be prior art to the present application. The Examiner has not established a publication date of the Pipinsure reference. The Examiner relies on the website <http://www.archive.org> for establishing that the Pipinsure reference was available as of 2000. However, there is no guarantee that the dates or even the content of what is supplied by <http://www.archive.org> is accurate. Appellant notes that the Terms of Use for <http://www.archive.org> (see <http://www.archive.org/about/terms.php>) state:

You understand and agree that the Archive makes no warranty or representation regarding the accuracy, currency, completeness, reliability, or usefulness of the content in the Collections, that the Site or the Collections will meet your requirements, that access to the Collections will be uninterrupted, timely, secure, or error free, or that defects, if any, will be corrected. We make no warranty of any kind, either express or implied.

Thus, since <http://www.archive.org> does not guarantee the accuracy of its collections, Appellant asserts that it is not proper to rely on <http://www.archive.org> to establish a publication date. Furthermore, even if the Pipinsure reference was published prior to Appellant's date of invention, there is no guarantee that the copy downloaded by the Examiner is an *accurate copy of what was published.* **This is especially true since <http://www.archive.org> specifically states that they do not guarantee the accuracy of their content.**

For the above reasons, Appellant asserts that there is insufficient evidence of record to establish that the Pipinsure reference downloaded by the Examiner qualifies as prior art. Also, as noted above, even if the Pipinsure reference is prior art, Pipinsure in view of Keuper fails to teach or suggest the specific limitations of claim 20 as demonstrated above.

Thus for at least the reasons presented above, the rejection of claim 20 is unsupported by the cited art and removal thereof is respectfully requested.

Second Ground of Rejection:

Claims 4, 6, 9 and 19 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Pipinsure in view of Keuper in further view of Kadaba. Appellant traverses these rejections for at least the following reasons. Different groups of claims are addressed under their respective subheadings.

Claim 4

In regard to claim 4, Pipinsure in view of Keuper in further view of Kadaba fails to teach or suggest forwarding copies of at least a portion of the data file via the network to one or more of the parties involved in the shipping, wherein the parties include at least an originator of the request to ship the item, a recipient of the item at the final destination, and at least one insurance company. The Examiner cites page 8 to support the erroneous assertion that Pipinsure discloses “forwarding copies of at least a portion of the data file via the network to at least one insurance company.” As described above with respect to claim 1, Pipinsure fails to teach generating such data file. By extension, Pipinsure cannot teach or suggest forwarding copies of at least a portion of such data file to any entity, much less forwarding copies of at least a portion of the data file via the network to one or more of the parties involved in the shipping, wherein the parties include at least an originator of the request to ship the item, a recipient of the item at the final destination, and at least one insurance company.

The Examiner further cites the Abstract of Kadaba to support the erroneous assertion that Kadaba discloses “forwarding copies of at least a portion of the data file via the network to one or more of the parties involved in the shipping, wherein the parties includes at least an originator of the request to ship the item, a recipient of the item at the

final destination.” The Abstract fails to mention anything at all about forwarding copies of at least a portion of the data file via the network to one or more of the parties involved in the shipping, wherein the parties include at least an originator of the request to ship the item and a recipient of the item at the final destination. While Kadaba does mention a “portable data entry and data processing device to obtain signatures of recipients” (Abstract, emphasis added), Kadaba fails to teach or suggest forwarding copies of at least a portion of a data file (that comprises item information and insurer information) to such recipients. Additionally, Kadaba fails to teach or suggest forwarding copies of at least a portion of such a data file to an originator of the request to ship the item. **In fact, Kadaba fails to mention anything at all about a data file comprising item information and insurer information.** Clearly, Kadaba, even when combined with the teachings of Pipinsure and Keuper, fails to teach or suggest the specific limitations of claim 4.

Furthermore, Appellant asserts that the Examiner has failed to state a proper reason as to why one of ordinary skill in the art would have combined the teachings of Kadaba with the teaching of Pipinsure and Keuper. The Examiner asserts:

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Kadaba with the combined teachings of Pipinsure and Keuper with the motivation of providing an improved parcel tracking system capable of sharing parcel data with other computers (Kadaba: col. 3, lines 40-64). (emphasis added)

However, the Examiner has merely provided a reason to use the teachings of Kadaba alone, not a reason to combine the teaching of Kadaba with the teachings of Pipinsure and Keuper in order to create Appellant’s claimed invention. Indeed, one seeking to “provid[e] an improved parcel tracking system capable of sharing parcel data with other computers” would simply use the teachings of Kadaba alone (*see e.g.*, Kadaba column 3, lines 40-64).

Thus, for at least the reasons presented above, the rejection of claim 4 is unsupported by the cited art and removal thereof is respectfully requested.

Claim 6

In regard to claim 6, the cited art fails to teach or suggest the method of claim 1 further comprising forwarding a copy of the data file via a network to a central server. The Examiner admits PIPinsure fails to disclose this limitation. The Examiner relies on Keuper and Kadaba to disclose forwarding a copy of the data file via a network to a central server. The Examiner cites Kadaba. Kadaba discloses (column 2, lines 30-54):

Generally described, the present invention provides an electronic parcel tracking system for use by an organization, comprising an intelligent hand-held, portable data entry and data processing device, which includes a wand-mounted symbol reader, a data entry and display screen capable of receiving and displaying information, including signature information, input by contact with the screen, an information storage device, a data transfer device, and a processor connected to the reader, the screen, the storage device, and the data transfer device. The processor is configured to associate and store in the information storage device data related to a particular parcel, including symbol information read by the reader, signature information acquired by the screen, and keyed information acquired by the screen, and to respond to queries about the particular parcel entered via the screen by displaying the data associated with the parcel.

Preferably, the data transfer device is selectively operable to transfer information from the information storage device to a personal computer system located at a parcel receiving location of the organization. Also, the portable data entry device may be equipped with a modem for transferring information related to a particular parcel between the information storage device and a central computer system located at a parcel delivery firm. (emphasis added)

Clearly, Kadaba fails to disclose, in the cited art or elsewhere, a data file comprising insurer information. Instead, Kadaba teaches storing, in an information storage device, symbol information, signature information, and keyed information. Furthermore, neither PIPinsure, Keuper, nor Kadaba, taken singly or in combination, teach or suggest a data file comprising insurer information. The Examiner's combination of cited art fails to

teach or suggest forwarding a copy of the data file via a network to a central server, wherein the data file comprises insurer information.

In the Response to Arguments, the Examiner argues that since the physical structure of Keuper and Kabada's system is capable of forwarding a (any) data file to a central server, the combination or prior art therefore teaches the specific limitation of forwarding a copy of data file that includes item information and insurer information that accompanies an item to a central server, as recited in Appellants' claim. The Examiner's argument regarding a "recitation of intended use" and "structural differences" is irrelevant to Appellants' specific *method* claim limitation. Claim 6 does not recite an intended use of a physical structure. Instead, Claim 6 recites a specific method limitation of *copying* a specific data file, generated as recited in claim 1, to central server via a network. As noted above, the Examiner's combination of cited art does not teach or suggest the specific method limitation recited in claim 6. Whether or not a system resulting from the Examiner's combination of cited art would or would not be capable of copying such a data file via a network to a central server is irrelevant to the fact that the combination of cited art fails to teach or suggest such a limitation. Moreover, the Examiner still has not addressed the fact that none of the cited references teach a data file comprising insurer information. Thus, even if the references were combined as suggested by the Examiner, such a combination would not result in Appellant's claimed invention as recited in claim 6.

Furthermore, Appellant asserts that the Examiner has failed to state a proper reason as to why one of ordinary skill in the art would have combined the teachings of Kadaba with the teaching of Pipinsure and Keuper. The Examiner asserts:

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Kadaba with the combined teachings of Pipinsure and Keuper with the motivation of providing an improved parcel tracking system capable of sharing parcel data with other computers (Kadaba: col. 3, lines 40-64). (emphasis added)

However, the Examiner has merely provided a reason to use the teachings of Kadaba alone, not a reason to combine the teaching of Kadaba with the teachings of Pipinsure and Keuper in order to create Appellant's claimed invention. Indeed, one seeking to "provid[e] an improved parcel tracking system capable of sharing parcel data with other computers" would simply use the teachings of Kadaba alone (*see e.g.*, Kadaba column 3, lines 40-64).

Thus, for at least the reasons presented above, the rejection of claim 6 is unsupported by the cited art and removal thereof is respectfully requested.

Claim 9

Appellants assert claim 9 is in condition for allowance for at least the reasons presented above in regard to claim 1. Furthermore, Appellant asserts that the Examiner has failed to state a proper reason as to why one of ordinary skill in the art would have combined the teachings of Kadaba with the teaching of Pipinsure and Keuper. The Examiner asserts:

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Kadaba with the combined teachings of Pipinsure and Keuper with the motivation of providing an improved parcel tracking system capable of sharing parcel data with other computers (Kadaba: col. 3, lines 40-64). (emphasis added)

However, the Examiner has merely provided a reason to use the teachings of Kadaba alone, not a reason to combine the teaching of Kadaba with the teachings of Pipinsure and Keuper in order to create Appellant's claimed invention. Indeed, one seeking to "provid[e] an improved parcel tracking system capable of sharing parcel data with other computers" would simply use the teachings of Kadaba alone (*see e.g.*, Kadaba column 3, lines 40-64).

Thus, for at least the reasons presented above, the rejection of claim 9 is unsupported by the cited art and removal thereof is respectfully requested.

Claim 19

In regard to claim 19, Appellant asserts the rejection of claim 19 is unsupported by the cited art for at least reasons similar to those presented above in regard to claim 1. **Furthermore, Appellant asserts neither PIPinsure, Keuper, nor Kadaba, taken singly or in combination, teach or suggest a server connected to the memory device, wherein the server is configured to receive a request to insure the item being shipped from an origination to a final destination, search a database for a cost effective insurance, wherein the cost effective insurance provides maximum insurance coverage for the item for the least cost, generate a data file comprising at least the following item information, and insurer information, and store the data file in the memory device that accompanies the item.** The Examiner asserts “Claim 19 substantially repeats the same limitations as claims 1, 6, and 9 and therefore, is rejected for the same reasons given for claims 1, 6, 9 and incorporated herein.” **The Examiner has improperly ignored the specific differences between the claim limitations of claims 1 and 19.** Neither claims 1, 6, nor 9 - referred to by the Examiner in the rejection of claim 19 - recite a server configured as recited in claim 19. Furthermore, claims 6 and 9 recite limitations that are very different than the limitations of claim 19.

In the Response to Arguments, the Examiner fails to explain how the rejection of claim 19 addresses the differences between claims 1, 6, 9 and 19. Instead, the Examiner merely repeats the Examiner’s speculation, unsupported by evidence or explanation, that the combination cited art, “does indeed teach and suggest Applicant’s claimed features.” Moreover, the Examiner’s statement that the rejection of claim 19 “substantially repeated the same limitations” as claims 1, 6 and 9, does not actually address the **actual differences** between the claims.

Additionally in regard to claim 19, the cited art also fails to teach or suggest a server configured to search a database for a cost effective insurance providing maximum insurance coverage for an item for the least cost. For example, the cited art of PIPinsure discloses a web form a user may fill out to request a savings quote. The

Examiner also cites PIPinsure's simple table of annual potential savings dependent on a declared package value and number of shipments per day. A *savings quote* and a *table of potential savings* have nothing to do with providing maximum insurance coverage for an item for the least cost as recited in claim 19. Furthermore, Keuper discloses a barrel tag transponder that stores data pertaining to the contents of the barrel. The cited art of Keuper has absolutely nothing to do with *insurance* much less providing maximum insurance coverage for an item for the least cost. Keuper and PIPinsure, taken singly or in combination, fail to disclose providing maximum insurance coverage for an item for the least cost. Additionally, Kadaba teaches storing, in an information storage device, symbol information, signature information, and keyed information. Thus, Kadaba, like Keuper, is absolutely silent in regard to item *insurance* much less providing maximum insurance coverage for an item for the least cost. Kadaba, Keuper, and PIPinsure, taken singly or in combination, fail to disclose providing maximum insurance coverage for an item for the least cost. The Examiner fails to address this argument in the Response to Arguments.

Furthermore, the Pipinsure reference has not been shown to be prior art to the present application. The Examiner has not established a publication date of the Pipinsure reference. The Examiner relies on the website <http://www.archive.org> for establishing that the Pipinsure reference was available as of 2000. However, there is no guarantee that the dates or even the content of what is supplied by <http://www.archive.org> is accurate. Appellant notes that the Terms of Use for <http://www.archive.org> (see <http://www.archive.org/about/terms.php>) state:

You understand and agree that the Archive makes no warranty or representation regarding the accuracy, currency, completeness, reliability, or usefulness of the content in the Collections, that the Site or the Collections will meet your requirements, that access to the Collections will be uninterrupted, timely, secure, or error free, or that defects, if any, will be corrected. We make no warranty of any kind, either express or implied.

Thus, since <http://www.archive.org> does not guarantee the accuracy of its collections, Appellant asserts that it is not proper to rely on <http://www.archive.org> to establish a publication date. Furthermore, even if the Pipinsure reference was

published prior to Appellant's date of invention, there is no guarantee that the copy downloaded by the Examiner is an *accurate copy of what was published*. **This is especially true since <http://www.archive.org> specifically states that they do not guarantee the accuracy of their content.**

For the above reasons, Appellant asserts that there is insufficient evidence of record to establish that the Pipinsure reference downloaded by the Examiner qualifies as prior art. Also, as noted above, even if the Pipinsure reference is prior art, Pipinsure in view of Keuper in further view of Kadaba fails to teach or suggest the specific limitations of claim 19 as demonstrated above.

Thus for at least the reasons presented above, the rejection of claim 19 is unsupported by the cited art and removal thereof is respectfully requested.

Third Ground of Rejection:

Claims 5, 7, 10-11 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Pipinsure in view of Keuper in further view of Official Notice. Appellant traverses these rejections for at least the following reasons. Different groups of claims are addressed under their respective subheadings.

Claim 5

In regard to claim 5, the cited art fails to teach or suggest the method of claim 1, further comprising forwarding copies of the data file via the network to one or more predetermined email addresses. Furthermore, the Examiner takes official notice that "it is old and well known within the computer arts to transmit information via a network to an email address." Pursuant to M.P.E.P. § 2144.03, Appellant previously traversed the Examiner's taking of official notice in the context of Appellant's claimed invention. Appellant asserts that it was not well known in the prior art to transmit copies of a data file including item information and insurer information via a network to one or

more predetermined email addresses, *in the specific context of Appellants' invention*. In fact, as discussed above, neither PIPinsure nor Keuper, taken singly or in combination, disclose a generating a data file with item information and insurer information much less forwarding copies of that type of data file via the network to one or more predetermined email addresses. Pursuant to M.P.E.P. § 2144.03 Appellant asserted in the previous response that the Examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See also 37 CFR 1.104(c)(2), (d)(2) and *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

The Examiner failed to provide any documentary evidence to support the Official Notice. Instead, the Examiner states, “Applicant’s traversal of Official Notice was inadequate because Applicant did not state why the noticed fact is not considered to be common knowledge or well-known in the art” and “[a]s such, the features rejected via Official Notice are deemed to be admitted prior art.” However, Appellant submits that Appellant adequately traversed the Examiner’s taking of Official Notice and that it was not well known *in the context of Appellants' invention* to transmit copies of a data file including item information and insurer information via a network to one or more predetermined email addresses.

Furthermore, Appellant’s claim does not recite merely transmitting information via a network to an email address. Instead, claim 5 requires that copies of a specific data file that is also stored in a memory device that accompanies the item being shipped are forwarded to one or more predetermined email addresses. This *specific limitation* is not disclosed by any evidence of record. Even if general prior art email transmissions referred to by the Examiner were combined with PIPinsure and Keuper, it would not suggest the specific limitation recited in claim 5.

Furthermore, the Examiner has not provided any reason to modify the systems of PIPinsure and Keuper according to the Examiner’s Official Notice. Therefore, a *prima facie* rejection has not been stated.

Thus for at least the reasons presented above, the rejection of claim 5 is unsupported by the cited art and removal thereof is respectfully requested.

Claim 7

In regard to claim 7, the cited art fails to teach or suggest the method of claim 1, further comprising further comprising shipping the item using the least expensive routing. Furthermore, the Examiner takes official notice that “it is old and well known within the shipping and parcel delivery arts to ship items using the least expensive routing.” Pursuant to M.P.E.P. § 2144.03, Appellant traverses the Examiner’s taking of official notice *in the context of Appellant’s claimed invention*. Appellant asserts that it was not well known in the prior art to ship items using the least expensive routing *wherein the item is accompanied by a memory device that stores a data file containing at least item information and insurer information*. In fact, as discussed above, neither PIPinsure nor Keuper, taken singly or in combination, disclose shipping an item using the least expensive routing wherein the item is accompanied by a memory device that stores a data file containing insurer information. Pursuant to M.P.E.P. § 2144.03 Appellant asserts that the examiner must provide documentary evidence if the rejection is to be maintained. See also 37 CFR 1.104(c)(2), (d)(2) and *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). **The Examiner failed to provide any documentary evidence to support the Official Notice.** Instead, the Examiner states, “Applicant’s traversal of Official Notice was inadequate because Applicant did not state why the noticed fact is not considered to be common knowledge or well-known in the art” and “[a]s such, the features rejected via Official Notice are deemed to be admitted prior art.” However, Appellant submits that Appellant adequately traversed the Examiner’s taking of Official Notice and that it was not well known in the context of Appellants’ invention to ship items using the least expensive routing. There are many instance in which a more expensive routing may be used, such as to obtain faster shipping. Thus, even if shipping using the least expensive routing was known in other contexts, it was not known for the specific combination of limitations recited in claims 1 and 7.

Furthermore, the Examiner has not provided any reason to modify the systems of PIPinsure and Keuper according to the Examiner's Official Notice. Therefore, a *prima facie* rejection has not been stated.

Thus for at least the reasons presented above, the rejection of claim 7 is unsupported by the cited art and removal thereof is respectfully requested.

Claim 10

In regard to claim 10, the cited art fails to teach or suggest the method of claim 1, wherein storing the data file comprises data in an XML format. Furthermore, the Examiner takes official notice that “it is old and well known within the computer arts to store data in eXtensible Markup Language (XML) format.” Pursuant to M.P.E.P. § 2144.03, Appellant traverses the Examiner’s taking of official notice in the context of Appellant’s claimed invention. Appellant asserts that it was not well known in the prior art to store a data file that comprises data in an XML format *wherein the data file is stored in a memory device that accompanies an item*. In fact, as discussed above, neither PIPinsure nor Keuper, taken singly or in combination, discloses that storing the data file comprises data in an XML format *where the data file is stored in a memory device that accompanies an item and where the data file includes at least item information and insurer information*. Pursuant to M.P.E.P. § 2144.03 Appellant asserts that the examiner must provide documentary evidence if the rejection is to be maintained. See also 37 CFR 1.104(c)(2), (d)(2) and *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). **The Examiner failed to provide any documentary evidence to support the Official Notice.** Instead, the Examiner states, “Applicant’s traversal of Official Notice was inadequate because Applicant did not state why the noticed fact is not considered to be common knowledge or well-known in the art” and “[a]s such, the features rejected via Official Notice are deemed to be admitted prior art.” However, Appellant submits that Appellant adequately traversed the Examiner’s taking of Official Notice and that it was not well known in the context of Appellants’ invention to store a data file that comprises data in an XML format *wherein the data file is stored in a memory device that*

accompanies an item. XML may be known in the prior art for other purposes, but it is not used in the prior art for a data file including the specific information recited in Appellant's claims and stored in a memory device accompanying an item being shipped.

Furthermore, the Examiner has not provided any reason to modify the systems of PIPinsure and Keuper according to the Examiner's Official Notice. Therefore, a *prima facie* rejection has not been stated.

Thus for at least the reasons presented above, the rejection of claim 10 is unsupported by the cited art and removal thereof is respectfully requested.

Claim 11

In regard to claim 11, the cited art fails to teach or suggest the method of claim 9, wherein the network data is exchanged in an XML format. Furthermore, the Examiner takes official notice that “it is old and well known within the computer arts to exchange network data in an XML format.” Pursuant to M.P.E.P. § 2144.03, Appellant traverses the Examiner’s taking of official notice in the context of Appellant’s claimed invention. Appellant asserts that it was not well known in the prior art to exchange data in an XML format on a network *wherein the data includes at least item information and insurer information.* In fact, as discussed above, neither PIPinsure nor Keuper, taken singly or in combination, discloses exchanging data including both item information and insurer information in an XML format on a network. Pursuant to M.P.E.P. § 2144.03 Appellant asserts that the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See also 37 CFR 1.104(c)(2), (d)(2) and *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). **The Examiner failed to provide any documentary evidence to support the Official Notice.** Instead, the Examiner states, “Applicant’s traversal of Official Notice was inadequate because Applicant did not state why the noticed fact is not considered to be common knowledge or well-known in the art” and “[a]s such, the features rejected via Official Notice are deemed to be admitted prior art.” However, Appellant submits that Appellant adequately traversed the

Examiner's taking of Official Notice and that it was not well known in the context of Appellants' invention to exchange network data in an XML format. XML may be known in the prior art for other purposes, but it is not used in the prior art for the specific network data exchange recited in Appellant's claims.

Furthermore, the Examiner has not provided any reason to modify the systems of PIPinsure and Keuper according to the Examiner's Official Notice. Therefore, a *prima facie* rejection has not been stated.

Thus for at least the reasons presented above, the rejection of claim 11 is unsupported by the cited art and removal thereof is respectfully requested.

Fourth Ground of Rejection:

Claim 16 stands finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Pipinsure in view of Keuper in further view of eBay. Appellant traverses this rejection for at least the following reasons. Different groups of claims are addressed under their respective subheadings.

Claim 16

In regard to claim 16, eBay, even when combined with the teachings of Pipinsure and Keuper, fails to teach or suggest wherein the data file further comprises one or more digital images of the item before, during, or after shipping. The Examiner cites eBay (eBay: Why eBay is Safe; How to Add a Photo to Your Item Listing) to disclose the above limitation. First, Appellants note that the content of eBay (<http://web.archive.org/web/19991110180343/http://www.eBay.com/index.html>) fails to disclose anything about "How to Add a Photo to Your Item Listing," contrary to the Examiner's assertion. Furthermore, the web page accessed through the hyperlink entitled "Why eBay is Safe" fails to disclose anything about digital images, much less wherein

the data file, which accompanies the item, further comprises one or more digital images of the item before, during, or after shipping.

Furthermore, the eBay reference has not been shown to be prior art to the present application. The Examiner has not established a publication date of the eBay reference. The Examiner relies on the website <http://www.archive.org> for establishing that the eBay reference was available as of 1999. However, there is no guarantee that the dates or even the content of what is supplied by <http://www.archive.org> is accurate. Appellant notes that the Terms of Use for <http://www.archive.org> (see <http://www.archive.org/about/terms.php>) state:

You understand and agree that the Archive makes no warranty or representation regarding the accuracy, currency, completeness, reliability, or usefulness of the content in the Collections, that the Site or the Collections will meet your requirements, that access to the Collections will be uninterrupted, timely, secure, or error free, or that defects, if any, will be corrected. We make no warranty of any kind, either express or implied.

Thus, since <http://www.archive.org> does not guarantee the accuracy of its collections, Appellant asserts that it is not proper to rely on <http://www.archive.org> to establish a publication date. Furthermore, even if the eBay reference was published prior to Appellant's date of invention, there is no guarantee that the copy downloaded by the Examiner is an *accurate copy of what was published*. **This is especially true since <http://www.archive.org> specifically states that they do not guarantee the accuracy of their content.**

Furthermore, when attempting to access the link for the eBay reference at <http://web.archive.org/web/19991110180343/http://www.eBay.com/index.html>, it is noted that not all portions of the reference are available under that date. For example, the portion of eBay related to "How to Add a Photo to Your Item Listing" is not present. Thus, contrary to the Examiner's assertion, it does not appear that <http://web.archive.org/web/19991110180343/http://www.eBay.com/index.html> has a record of all portions of eBay being publicly available as of 1999.

For the above reasons, Appellant asserts that there is insufficient evidence of record to establish that the eBay reference downloaded by the Examiner qualifies as prior art. Also, as noted above, even if the eBay reference is prior art, Pipinsure in view of Keuper in further view of eBay fail to teach or suggest wherein the data file, which accompanies the item, further comprises one or more digital images of the item before, during, or after shipping.

Thus for at least the reasons presented above, the rejection of claim 16 is unsupported by the cited art and removal thereof is respectfully requested.

Fifth Ground of Rejection:

Claims 17 stands finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Pipinsure in view of Keuper in further view of Chen. Appellant traverses this rejection for at least the following reasons. Different groups of claims are addressed under their respective subheadings.

Claim 17

In regard to claim 17, Pipinsure in view of Keuper in further view of Chen fails to teach or suggest wherein the data file further comprises one or more digital images of the item showing the physical condition of the item upon receipt. The Examiner cites the Abstract of Chen, which is reproduced below:

A communications network for processing insurance claims of objects. The communications network including claim terminals and repair terminals, each having a processor, a display monitor, and a mass storage device, for inputting and sending object-identification data, parts graphics images, and images from the claims terminals to the repair terminals through a communications channel. The repair terminals compute repair and replacement estimates and send the estimates to the claim terminal. The object-identification data include information stored in digital form for a multiplicity of objects. The sum of the costs for repairing an object or a part of an object versus the cost for replacing the object or the part of a object is compared. An imaging device may be used for capturing an electronic image in digital form of the damaged object. The display

monitor displays the electronic image along with lists of parts of the damaged object, a parts description, or with a selected first part and a parts graphics image. A method for processing insurance claims of objects is also provided. (emphasis added)

Chen describe an imaging device for capturing an electronic image of a damaged object. **Nowhere does Chen teach or suggest that his electronic image is comprised within a data file that is stored in a memory device that accompanies the item being shipped.** Accordingly, Chen, even when combined with the teaching of Pipinsure and Keuper, fails to teach or suggest wherein the data file further comprises one or more digital images of the item showing the physical condition of the item upon receipt.

The Examiner further asserts that “taking photographs of items to document the physical condition of the items at different times (e.g., after shipment, etc.) for, *inter alia*, evidentiary and/or insurance claim purposes is notoriously well known” and cites parcel carriers, such as FedEx and UPS, as well as car rental agencies in support of his assertion. First, **Appellant does not claim “taking photographs of items to document the physical condition of the items at different times (e.g., after shipment, etc.) for, *inter alia*, evidentiary and/or insurance claim purposes.”** Therefore the Examiner’s comment is not relevant. Instead, Appellant claims wherein the data file further comprises one or more digital images of the item showing the physical condition of the item upon receipt. The Examiner has not addressed the specific limitations of claim 17. Furthermore, the Examiner’s assertions related to FedEx, UPS, and car rental agencies are not supported by any **evidence of record**. Accordingly, a rejection that relies on such assertions is improper.

Furthermore, Appellants assert that the Examiner has not stated a proper reason as to why one of ordinary skill in the art would have combined the teachings of Chen with the teachings of Pipinsure and Keuper to create Appellant’s claimed invention. The Examiner asserts:

One of ordinary skill in the art would have found it obvious at the time of the invention to combine the teachings of Chen and knowledge generally available to one having ordinary skill in the art with the combined

teaching of Pipinsure and Keuper with the motivation of providing a means for assessing damage for insurance claim processing purposes (Chen: Abstract). (emphasis added)

However, one seeking to “provid[e] a means for assessing damage for insurance claim processing purposes” would simply use Chen’s system alone (*see e.g.*, Chen, Abstract). The Examiner has merely stated a reason for one skilled in the art to use the system of Chen, not a reason as to why one of ordinary skill in the art would be motivated to combine the teachings of Chen with the teachings of Pipinsure and Keuper to create Appellant’s claimed invention.

Thus for at least the reasons presented above, the rejection of claim 17 is unsupported by the cited art and removal thereof is respectfully requested.

Sixth Ground of Rejection:

Claims 18 stands finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Pipinsure in view of Keuper in further view of Kepler. Appellant traverses this rejection for at least the following reasons. Different groups of claims are addressed under their respective subheadings.

Claim 18

In regard to claim 18, Pipinsure in view of Keuper in further view of Kepler fails to teach or suggest wherein the memory device comprises an air testing device configured to test air samples for contaminants and to store test results in the data file. The Examiner cites column 2, lines 25-35 of Kepler, which is reproduced below:

...probe through the film patch. An air contaminant detection apparatus is interconnected with the probe such that a test sample of air from within the shipping container may be admitted to the air contaminant detection apparatus. A means for indicating the presence of a contaminant is further provided along with an apparatus for sorting the shipping container containing a refrigerator in response to a presence of the contaminant.

Accordingly, an object of the present invention is to detect the presence of contaminants in the air contained in a shipping container.

The Examiner also cites the Abstract of Keuper. While Keplar discloses an air contaminant detection apparatus, and Keuper discloses a “keg tag,” neither Keplar nor Keuper, taken singly or in combination, teach or suggest a memory device, which accompanies the item, that comprises an air testing device configured to test air samples for contaminants and to store test results in the data file. In fact, Keplar actually teaches away from such a memory device by teaching an air contaminant detection apparatus (*see e.g.*, Figure 1, item 30; column 3, lines 30-50) that is separate from and does not accompany Keplar’s shipping container (*see e.g.*, Figure 1, item 12; column 3, lines 5-29). “A *prima facie* case of obviousness can be rebutted if the applicant...can show that the art in any material respect 'taught away' from the claimed invention...A reference may be said to teach away when a person of ordinary skill, upon reading the reference...would be led in a direction divergent from the path that was taken by the applicant.” *In re Haruna*, 249 F.3d 1327, 58USPQ2d 1517 (Fed. Cir. 2001). The air contaminant detection apparatus of Keplar is specifically separate from and does not accompany Keplar’s shipping container.

Thus for at least the reasons presented above, the rejection of claim 18 is unsupported by the cited art and removal thereof is respectfully requested.

CONCLUSION

For the foregoing reasons, it is submitted that the Examiner's rejection of claims 1-20 was erroneous, and reversal of the Examiner's decision is respectfully requested.

The Commissioner is authorized to charge the appeal brief fee of \$250.00 and any other fees that may be due to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5596-00901/RCK.

Respectfully submitted,

/Robert C. Kowert/

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VIII. CLAIMS APPENDIX

The claims on appeal are as follows.

1. A method for arranging insurance for an item, wherein the method comprises:

receiving a request to insure the item being shipped from an origination to a final destination;

searching a database for a cost effective insurance, wherein the cost effective insurance provides a specified level of insurance coverage for the item;

generating a data file comprising at least the following:

item information, and

insurer information; and

storing the data file in a memory device that accompanies the item.

2. The method as recited in claim 1, wherein the memory device is configured to allow the data file to be updated at any time before, during or after the shipment.

3. The method as recited in claim 1, further comprising packing the item in a container for shipping, wherein the container is configured to fit with multiple other containers in a carrier.

4. The method as recited in claim 1, further comprising forwarding copies of at least a portion of the data file via the network to one or more of the parties involved in

the shipping, wherein the parties include at least an originator of the request to ship the item, a recipient of the item at the final destination, and at least one insurance company.

5. The method as recited in claim 1, further comprising forwarding copies of the data file via the network to one or more predetermined email addresses.

6. The method as recited in claim 1, further comprising forwarding a copy of the data file via a network to a central server.

7. The method as recited in claim 1, further comprising shipping the item using the least expensive routing.

8. The method as recited in claim 1, wherein the data file further comprises contact information for at least one of the insurance companies that will insure the item.

9. The method as recited in claim 1, further comprising storing the data file on a server connected to a network, wherein the server provides access to the data file via the network.

10. The method as recited in claim 1, wherein storing the data file comprises data in an XML format.

11. The method as recited in claim 9, wherein the network data is exchanged in an XML format.

12. The method as recited in claim 1, wherein the data file further comprises item weight information.

13. The method as recited in claim 1, wherein the data file further comprises item handling information.

14. The method as recited in claim 1, wherein the data file further comprises item content information.

15. The method as recited in claim 1, wherein the data file further comprises insurance information.

16. The method as recited in claim 1, wherein the data file further comprises one or more digital images of the item before, during, or after shipping.

17. The method as recited in claim 1, wherein the data file further comprises one or more digital images of the item showing the physical condition of the item upon receipt.

18. The method as recited in claim 1, wherein the memory device comprises an air testing device configured to test air samples for contaminants and to store test results in the data file.

19. A system for arranging insurance for an item being shipped, wherein the system comprises:

a memory device, wherein the memory device stores information about the item, wherein the memory device accompanies the item; and

a server connected to the memory device, wherein the server is configured to communicate with the memory device using a network, wherein the server is configured to:

receive a request to insure the item being shipped from an origination to a final destination;

search a database for a cost effective insurance, wherein the cost effective insurance provides maximum insurance coverage for the item for the least cost;

generate a data file comprising at least the following:

item information, and

insurer information; and

store the data file in the memory device that accompanies the item.

20. A computer-readable storage medium which stores program instructions, wherein the program instructions are executable by a computer system to implement a method of:

receiving a request to insure the item being shipped from an origination to a final destination;

searching a database for a cost effective insurance, wherein the cost effective insurance provides maximum insurance coverage for the item for the least cost;

generating a data file comprising at least the following:

item information, and

insurer information; and

storing the data file in a memory device that accompanies the item.

IX. EVIDENCE APPENDIX

No evidence submitted under 37 CFR §§ 1.130, 1.131 or 1.132 or otherwise entered by the Examiner is relied upon in this appeal.

X. RELATED PROCEEDINGS APPENDIX

There are no related proceedings.